UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,634	12/29/2003	Carlos I. McEvilly	29505/39547	5732

4743	7590	03/10/2005

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER
LY, NGHI H

ART UNIT	PAPER NUMBER
2686	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/747,634	MCEVILLY ET AL.
	Examiner	Art Unit	
	Nghi H. Ly	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .
2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-27* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-27* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____ .
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-3, 9-12, 14, 15, 18, 20-23 and 25-27 are rejected under 35

U.S.C. 102(e) as being anticipated by Thiriet (US 6,650,892).

Regarding claim 1, Thiriet teaches a method of preparing a message

comprising: receiving a message content and an encoding method associated with the

message content (see column 3, lines 6-13), and encoding the message content to

provide an encoded message the encoded message comprising at least one

entertainment component (see column 3, lines 6-13 and column 3, lines 19-21, see

"game").

Regarding claim 2, Thiriet teaches providing an animation of the encoding

method (column 3, lines 19-21, see "game". The teaching of Thiriet inherently teaches

"an animation").

Regarding claim 3, Thiriet teaches the allowing the sender to interact with the

encoded message (see column 3, lines 6-13 and column 3, lines 33-36).

Regarding claim 9, Thiriet teaches associating an aural, visual or haptic element with the encoded message (column 3, lines 52-60).

Regarding claim 10, Thiriet teaches downloading a software component for performing the encoding method (see column 3, lines 6-13 and column 3, lines 33-36).

Regarding claim 11, Thiriet teaches receiving the message content includes receiving at least one of text, graphics, audio, video, digitized photographs and multimedia (lines 19-21, see "game").

Regarding claim 12, Thiriet teaches the encoding the message content further comprises encoding the message content to provide the at least one message component, the *at least one* message component comprising one of an added data, a data substituted for an existing data, a multimedia element, a game, a puzzle and an interactive element (see column 3, lines 6-13 and column 3, lines 19-21, see "game").

Regarding claim 14, Thiriet teaches a method of processing an encoded message comprising: receiving the encoded message (see column 3, lines 6-13 and column 3, lines 19-21, see "game"), the encoded message comprising a message content and at least one entertainment component (column 3, lines 19-21, see "game"), determining a decoding method according to supplemental data accompanying the encoded message (see column 3, lines 6-13 and column 3, lines 19-21, see "game"), and providing the message content and the at least one entertainment component to a recipient of the encoded message (see column 3, lines 6-13 and column 3, lines 19-21, see "game").

Regarding claim 15, Thiriet teaches receiving the encoded message further

comprises receiving the at least one entertainment component having one of an aural,
visual or haptic element (column 3, lines 52-60).

Regarding claim 18, Thiriet teaches interacting with the encoded message (see
column 3, lines 6-13 and see column 3, lines 33-36).

Regarding claim 20, Thiriet teaches providing the message content and the at
least one entertainment component further comprises providing the at least one
entertainment component having one of an added data, a data substituted for an
existing data, a multimedia element, a game, a puzzle and an interactive element. (see
column 3, lines 6-13 and column 3, lines 19-21, see "game").

Regarding claim 21, Thiriet teaches a electronic device (see fig.1, "MS") for
providing an encoded message comprising: a user interface for entering a message
content, and a processor coupled to the user interface (see fig.1, "PRM" and "KEY"), the
processor for receiving from the user interface the message content and an instruction
for encoding the message content (see column 3, lines 33-36), wherein the processor
provides the encoded message according to the instruction (see column 3, lines 6-13
and column 3, lines 19-21, see "game"), the encoded message comprising at least one
entertainment element (see column 3, lines 6-13 and column 3, lines 19-21, see
"game").

Regarding claim 22, Thiriet teaches at least one entertainment element
comprises one of an aural element, a visual element and a haptic element (column 3,
lines 52-60).

Regarding claim 23, Thiriet teaches the processor substitutes a portion of

the message content with the one of the aural element (fig.1, see "PRM"), the visual

element and the haptic element to create the encoded message (column 3, lines 52-60).

Regarding claim 25, Thiriet teaches at least one entertainment element is a

game and a text portion of the message is associated with the game (column 3, lines

19-21, see "game").

Regarding claim 26, Thiriet teaches at least one entertainment element is a

multimedia element and the multimedia element comprises one of text from the

message content and symbols representing one of text, graphics, audio, video, digitized

photographs and multimedia from the message content (column 3, lines 19-21, see

"game").

Regarding claim 27, Thiriet teaches the at least one entertainment component

comprises one of an added data, a data substituted for an existing data, a multimedia

element, a game, a puzzle and an interactive element (see column 3, lines 6-13 and

column 3, lines 19-21, see "game").

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.   Claims 4, 6, 7, and 13 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Thiriet (US 6,650,892) in view of Rincon et al (US 6,512,448).

        Regarding claim 4, Thiriet teaches encoding the message content (see column 3,

lines 6-13 and column 3, lines 33-36). Thiriet does not specifically disclose one of

mapping the message content and transforming the message content.

        Rincon teaches one of mapping the message content (see column 3, lines 30-35)

and transforming the message content (see column 6, lines 28-31).

        Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the teaching of Rincon into the system of Thiriet

in order to provide a multilingual wireless massage system that seamlessly maps

incompatible characters form a web browser form to characters supported by a recipient

wireless device (see Rincon, column 2, lines 59-63).

        Regarding claim 6, Thiriet teaches encoding the message (see column 3, lines 6-

13 and column 3, lines 33-36). Thiriet does not specifically disclose substituting a word

with another word, substituting the word with a symbol, substituting the word with audio, and substituting the word with an animation.

Rincon teaches substituting a word with another word, substituting the word with a symbol, substituting the word with audio, and substituting the word with an animation (see column 7, line 39-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rincon into the system of Thiriet in order to provide a multilingual wireless massage system that seamlessly maps incompatible characters form a web browser form to characters supported by a recipient wireless device (see Rincon, column 2, lines 59-63).

Regarding claim 7, Thiriet teaches encoding the message (see column 3, lines 6-13 and column 3, lines 33-36). Thiriet does not specifically disclose one of modifying the message content with an algorithm, modifying the message content to a multimedia format, and modifying the message content to an interactive format.

Rincon teaches one of modifying the message content with an algorithm, modifying the message content to a multimedia format, and modifying the message content to an interactive format (see column 7, line 39-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rincon into the system of Thiriet in order to provide a multilingual wireless massage system that seamlessly maps incompatible characters form a web browser form to characters supported by a recipient wireless device (see Rincon, column 2, lines 59-63).

Regarding claim 13, Thiriet teaches encoding the message (see column 3, lines 6-13 and column 3, lines 33-36). Thiriet does not specifically disclose supplementing the encoded message with a description corresponding to an encoding method used to provide the encoded message.

Rincon teaches supplementing the encoded message with a description corresponding to an encoding method used to provide the encoded message (see column 7, line 39-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rincon into the system of Thiriet in order to provide a multilingual wireless massage system that seamlessly maps incompatible characters form a web browser form to characters supported by a recipient wireless device (see Rincon, column 2, lines 59-63).

6.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thiriet (US 6,650,892) in view of Rincon et al (US 6,512,448) and further in view of Wiberg et al (US 6,628,946).

Regarding claim 5, the combination of Thiriet and Rincon teaches the substitution is performed while the message is one of in transit to a recipient and after receipt by the recipient (see Rincon, column 7, line 39-40). The combination of Thiriet and Rincon does not specifically disclose mapping places a tag in a message.

Wiberg teaches mapping places a tag in a message (see column 18, lines 3-322).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Wiberg into the system of Thiriet and Rincon in order to reduce battery consumption and improve standby time of the mobile station (see Wiberg, Abstract).

7.   Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiriet (US 6,650,892) in view of Olkkonen et al (US 6,842,460).

Regarding claim 8, Thiriet teaches the method of claim 7. Thiriet does not specifically disclose modifying the message content to an interactive format further includes modifying the message content to include a score-keeping component.

Olkkonen teaches modifying the message content to an interactive format further includes modifying the message content to include a score-keeping component (see column 5, lines 17-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Olkkonen into the system of Thiriet in order to maintain a record of the current status of the ad hoc network (see Olkkonen, column 5, lines 15-16).

Regarding claim 19, Thiriet teaches the method of claim 18. Thiriet does not specifically disclose keeping a score while interacting with the encoded message, wherein a predetermined score is required to view a portion of the encoded message.

Olkkonen teaches keeping a score while interacting with the encoded message, wherein a predetermined score is required to view a portion of the encoded message (see column 5, lines 17-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Olkkonen into the system of Thiriet in order to maintain a record of the current status of the ad hoc network (see Olkkonen, column 5, lines 15-16).

8.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thiriet (US 6,650,892) in view of Nagvi et al (US 6,714,777).

Regarding claim 16, Thiriet teaches encoding the message (see column 3, lines 6-13 and column 3, lines 33-36). Thiriet does not specifically disclose selecting a software component for interacting with the encoded message using information provided with the encoded message.

Nagvi teaches selecting a software component for interacting with the encoded message using information provided with the encoded message (see column 17, lines 20-24 and see column 18, lines 4-7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Nagvi into the system of Thiriet in order to provide a proxy switch and method of use thereof in a mobile communication network (see Naqvi, column 5, lines 5-7).

9.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thiriet

(US 6,650,892) in view of Nagvi et al (US 6,714,777) and further in view of Khare et al

(US 6,819,660).

Regarding claim 17, the combination of Thiriet and Naqvi teaches claim 16. The

combination of Thiriet and Naqvi does not specifically disclose obtaining the software

component when it is unavailable locally

Khare teaches obtaining the software component when it is unavailable locally

(see column 9, lines 49-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the teaching of Khare into the system of Thiriet

and Nagvi in order to simplify the process of upgrading software.

10.   Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thiriet

(US 6,650,892) in view of Zucker et al (US 6,468,155).

Regarding claim 24, Thiriet teaches encoding the message (see column 3, lines

6-13 and column 3, lines 33-36). Thiriet does not specifically disclose the processor

alters the message by means of an algorithm to provide a portion of the message as a

puzzle, the puzzle being the at least one entertainment element of the encoded

message.

Zucker teaches the processor alters the message by means of an algorithm to

provide a portion of the message as a puzzle, the puzzle being the at least one

entertainment element of the encoded message (see column 21, lines 15-23 and

column 21, lines 32-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the teaching of Zucker into the system of Thiriet

in order to provide systems and methods to facilitate games of skill for prizes played via

a communication network (see Zucker, column 3, lines 14-17).

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

   a. Motohashi (US 5,729,209) teaches radio selective call receiver with having

   electronic pocket notebook function for organizing messages.

   b. LaDue (US 6,144,859) teaches wireless cellular communication system and

   apparatus.

   c. Payne (US 6,735,614) teaches contact alerts for unconnected users.

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164.

The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

03/04/05

Marsha O Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600